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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,347	05/07/2001	Yoshinori Marumo	PW 0279466 FEL0102-US-A	1114
909 7590 06/04/2004 PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			EXAMINER STINSON, FRANKIE L	
			ART UNIT 1746	PAPER NUMBER
DATE MAILED: 06/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/849,347

Applicant(s)

MARUMO ET AL.

Examiner

FRANKIE L. STINSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Applicant's election with traverse of GROUP I, claims 1-12 in papers filed April 15, 2004 is acknowledged. The traversal is on the ground(s) that the subject matter is sufficiently related that a thorough search and examination of one group would necessarily encompass the search and examination of the remaining groups and that, as per MPEP §803, "If the search and examination of entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." In addition, MPEP §803 states that there are two criteria for a proper requirement for restriction between patentable distinct inventions: (A) the inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the examiner if restriction is required. It is respectfully submitted that the search and examination can be made without serious burden and that the criteria for a proper requirement set forth in MPEP §803 has not been met and that the requirement is improper and must be withdrawn. This is not found persuasive because. The instant application has been classified in the examiner's familiar class of 134/apparatus in which the examiner specializes. The non-elected claims are directed to a "method" of coating in the relatively, but not very, unfamiliar class 118 with approximately 29,367 patents and documents related to the instant subject matter in addition to the 70,084 patents/documents in the examiners specialized area. It is believed the applicant would best be served by having these claims examined by the examiners specializing in methods of coating since the Office specifically is structured in having examiners familiar with one or two or even three closely related arts and thereby ensuring the quality in examinations. The burden would

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be for the examiner to learn the art of class 118 and the associated offshoots to this class through examiner consultations only for examination of the instant application. Furthermore, the search for GROUP I claims is not required for the search of the non-elected claims.

The requirement is still deemed proper and is therefore made FINAL.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 5-8 and 110-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Japan 8-170177, Cowan Saieva or Pacholik (WO 00/5229).

Re claim 1, 7 and 12, Japan'177, Cowan, Saieva and Pacholik are each cited disclosing liquid treatment equipment, comprising: a treatment solution bath (1 in Japan'177; 12 in Cowan; 110 in Saieva, see fig. 2; and 28 in Pacholik) accommodating a treatment solution for implementing liquid treatment to a substrate to treat; a treatment solution circulating system (8 in Japan'177; 24, 26 in Cowan; unnumbered in Saieva; 1, 6, 26 in Pacholik), disposed connected to the treatment solution bath, that circulates the accommodated treatment solution between an outside of the treatment solution bath; a recycle bath (5, or 12 in Japan'177; 16 in Cowan; 120 in Saieva; and 7, 21 in Pacholik), disposed in a middle of the treatment solution circulating system, that is capable of reserving the circulated treatment solution and implements recycle treatment to the

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reserved treatment solution; and a product removal portion (10, 12 or 18 in Japan'177; 22, 34, 50 in Cowan; 150, 210a, 210b in Saieva; and 22, 8 in Pacholik) , disposed in the recycle bath, that removes a reaction product due to the liquid treatment contained in the reserved treatment solution. Re claims 5 and 8, Pacholik (as at 26) and Saieva (as at 310) disclose the electric absorbing unit. Re claims 6 and 9, Pacholik (as at 45) Japan'177 (as at 6) Cowan (as at 22) disclose the heating means. Re claim 10, Saieva discloses the reservoir tank (130). Re claim 11, Saieva discloses the buffer tank (430 or 410).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 8-170177, Cowan Saieva or Pacholik (WO 00/5229) in view of either Blachier et al. or Belongia et al.

Claim 2 defines over the applied prior art only in the recitation of the additive supplier that supplies an organic and/or sulfur additive agent. Blachier and Belongia are each cited disclosing in liquid treatment equipment means (see col. 1, lines 32-47 in Blachier and col. 1, lines 25-44 in Belongia), where there is disclosed that it is old and well known to provide supply organic and/or sulfur additives. It therefore would have been oblivious to one having ordinary skill in the art to modify the device of Japan'177, Cowan, Saieva or Pacholik, to include additives as taught by either Blachier or

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Belongia, for the purpose of enhancing the treatment process. Re claim 3, Blachier discloses the concentration measuring means (see col.8, lines 44-59). Re claim 4, Blachier discloses the volume/weight measuring means (see col. 11, lines 62-67).

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In Lancy, Meek et al., Dinella et al., Reinhardt et al., Bissinger, Faul et al., Anderson et al., Nakano et al., Wright, Jr., Selm, Steward, Snyder, and EPO'410, note the fluid treatment equipment.

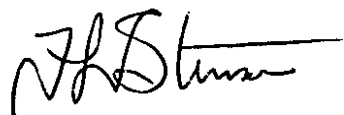
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANKIE L. STINSON whose telephone number is (571) 272-1308. The examiner can normally be reached M-F from 5:30 a.m. to 2:00 p.m. and some Saturdays from 5:30 a.m. to 11:30 a.m.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to TECHNOLOGY CENTER 1700 (571) 272-1700.

Any inquiry for missing parts of this Office Action (copies of references, pages, forms etc.), contact the TEAM LEADER Ms. Nicol Scott (571) 272-1045.

fls



FRANKIE L. STINSON  
Primary Examiner  
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